

REMARKS

A. Status of Claims

Claims 1-12, 18, and 24-30 are pending prior to the entry of the present Amendment. Of the preceding claims, Claims 8-9, 12, 24-25 have been canceled without prejudice. Claims 1-2, 6, 10-11, 26-28 and 30 are currently amended to delete subject matter that is beyond the Examiner's extended search group and to correct certain inadvertent typographical errors, for example, to change R^3 to R^1 in Claim 10. Support for these amendments can be found at least at the original claims, and at lines 20-22 of page 7 and lines 11-14 of page 11 of the specification as originally filed. No new matter is introduced by these amendments, and their entry is respectfully requested.

Applicants respectfully point out that the above cancelation of claims and amendments were made solely to expedite the prosecution of the instant application and in response to the Examiner's restriction requirements. Applicants are not representing that the canceled claims and non-elected subject matter are unpatentable, and are not acquiescing to the Examiner's position in any way. Applicants reserve the right to prosecute the non-elected subject matter and canceled claims in one or more continuation or divisional applications.

After the entry of the present Amendment, Claims 1-7, 10-11, 18 and 26-30 are pending.

B. Preliminary Observations - Election/Restrictions

The Examiner indicates that the search was narrower than the full scope of Claim 1 and that Claims 1-7, 11, 18 and 26-30 are being considered in the instant application in so far as they read on the extended search scope by the Examiner. In particular, the Examiner indicates that the search was limited to the following scope:

... The search has been extended to compounds represented by Formula A wherein R^6 is unsubstituted or substituted pyridinyl or phenyl, the ring containing Q, Y, X, T and Z is the same as it is in the elected species above, the ring containing U, W, and V is the same fused ring as in the elected species where the R groups are as broadly as represented by claim 1 when the ring is fused, or the ring containing U, W, and V is a phenyl ring, and the R groups are as broadly as represented by claim 1 when the ring is phenyl, and R^5 and J are as broadly as

represented by instant claim 1.

(Office Action Mailed January 02, 2009, carry-over paragraph on pages 2-3)

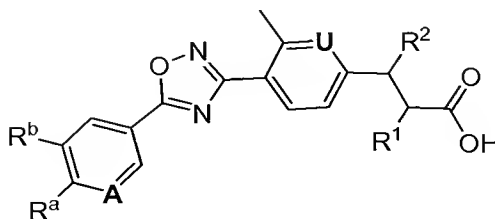
The Examiner further states that Claims 1-7, 11, 18 and 26-30 are being considered in the instant application in so far as they read on the extended search group:

Currently, Claims 1-12, 18, and 24-30 are pending in the instant application. Claims 1-7, 11, 18, and 28-29 read on the elected invention. Since the scope of the elected invention has been extended, Examiner will rejoin claims 26-27 and 30 as well. Therefore, Claims 1-7, 11, 18 and 26-30 read on the elected and extended invention and are under consideration in the instant application in so far as they read on the extended search group: ...

(Office Action mailed January 02, 2009, second full paragraph on page 3)

Applicants respectfully point out that the full scope of Claim 1 and its dependent claims should have been searched since these claims share a unity of invention. However, to expedite the prosecution of the instant application, Applicants have canceled Claims 8-9, 12, 24-25 without prejudice and amended Claims 1-2, 6-7, 10-11, 26-28 and 30 to the scope that is consistent with the Examiner's extended search group.

Applicants further point out that Claim 10, which has the following structure and wherein R^a , R^b , R^1 , R^2 , A and U are as defined in the table therein, should have been considered by the Examiner as this claim contains subject matter that is within the Examiner's extended search scope:



Thus, Applicants respectfully request that the currently amended Claim 10, which is fully within the Examiner's extended search group, be included in the instant application.

C. Claim Rejections – 35 U.S.C. §112, First Paragraph

Claims 1-5, 18 and 28-30 - The Examiner rejected Claims 1-5, 18 and 28-30 as allegedly failing to comply with the written description requirement. Specifically, the Examiner

states that the variable J is allegedly claimed broader than what is supported by the disclosure (emphasis added by the Examiner):

Claims 1-5, 18, and 28-30 are rejected under 35 U.S.C 112, 1st paragraph as failing to comply with the written description requirement.

...

The Guidelines ... specifically state that for each claim drawn to a genus the written description requirement may be satisfied through sufficient description of a representative number of species by a) actual reduction to practice; ... The analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated possession of the claimed invention. ... Below is such a comparison.

...

I. Scope of Claims

Compounds of Formula (A) as found in claim 1.

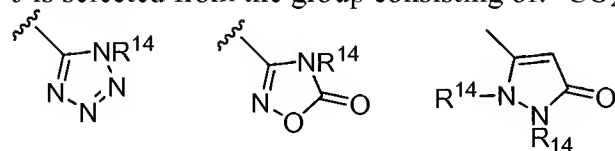
Variable J is claimed broader than what is supported by the disclosure (see section II below).

II. Scope of Disclosure

Reduction to Practice:

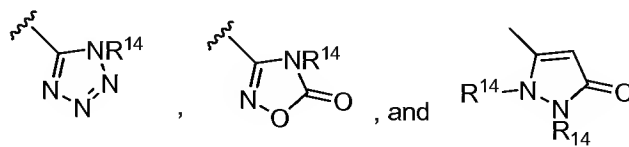
Compounds reduced to practice support the following substituents for variable J:

J is selected from the group consisting of: -CO₂H,



(Office Action mailed January 02, 2009, pages 4-6) Applicants respectfully traverse this rejection.

Applicants acknowledge the Examiner's indication that Claim 1 complies with the written description requirement at least as to the extent where J is selected from



the group consisting of: -CO₂H,

However, Applicants respectfully disagree with the Examiner regarding the rest of the J groups as Applicants believe all J groups of Claim 1 comply with the written description requirement since a skilled artisan would readily understand that Applicants did have possession of the claimed subject matter as of the filing date in view of the detailed

specification and the specification does provide adequate written description to identify the genus of the claim.

Nevertheless, to expedite the prosecution of the instant application, Applicants have amended Claims 1 and 28 to recite that group J is one of the four groups described above that have been reduced to practice as correctly stated by the Examiner. Applicants reserve the right to pursue the non-elected subject matter and canceled claims in a continuation or divisional application.

Additionally, Applicants have amended Claims 1-2, 18, 28 and 30 to delete subject matter that is beyond the Examiner's extended search group.

In light of the instant amendments, the 35 U.S.C. §112 rejection is moot. Applicants respectfully request withdrawal of this rejection and allowance of Claim 1 and its dependent Claims 2-5, 18 and 28-30.

D. Claim Objections

Claims 6-7, 11 and 26-27 - The Examiner objected to Claims 6-7, 11, and 26-27 for allegedly containing non-elected subject matter and for depending on a rejected base claim. Applicants respectfully traverse this rejection.

To expedite the prosecution of the instant application, Applicants have amended Claims 6, 11 and 26-27 to delete subject matter that is beyond the Examiner's extended search group. Moreover, as described above, the base Claim 1 has been amended to delete subject matter that is beyond the Examiner's extended search group and to recite that group J is one of the groups that have been reduced to practice. In light of these amendments, this objection is moot. Applicants respectfully request withdrawal of this objection and allowance of Claims 6-7, 11, and 26-27.

E. Claim 10

As presented above in section B, the currently amended Claim 10, which ultimately depends from Claim 1, is within the Examiner's extended search group. Applicants respectfully request that the Examiner consider Claim 10 in the instant application and allow this claim in light of the instant amendments as this claim fully complies with the written description

requirement.

F. Summary

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the pending claims and reexamination of the application. Timely allowance of the pending claims is respectfully requested.

The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the instant application. Applicants believe no additional fees are due, but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

By /Yong Zhao, Reg. # 57014/
Yong Zhao
Reg. No. 57,014
Attorney for Applicants

MERCK & CO., INC.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-7338

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